

LITIGATORS CORNER:

How to Communicate With a Client



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HOW DO YOU COMMUNICATE WITH A CLIENT?

In two words: Very carefully.

There are any number of occasions that require either written or oral communications between attorney and a client, or a prospective client. Unfortunately, effective communication has gotten harder, not easier. There are too many things competing for our finite attention span. In other words, there is too much "noise," and it is harder to be heard above the noise level. Also, there are many more ways to communicate, and everyone expects the communication to be instantaneous. There is e-mail. There is voicemail. There is the facsimile machine. There are Federal Express, DHL and UPS. There is regular mail. In short, there are too many ways to communicate; I've seen some people send the same message three ways.

In my years of practice, I have learned, often the hard way, how best to communicate effectively with clients and prospective clients. For an intellectual property attorney, the ordinary prospective client is often an individual inventor who believes he or she has a great idea, and wants to either patent or license it, or enforce an existing patent. That person contacts you, hoping you will have all the answers and can help bring the idea to fruition.

In the case of the client who wants to patent or license an invention, I try to gently bring him or her around to understanding that the process of getting and exploiting a patent is an extremely difficult one; the vast majority of patents do not result in commercial success. For instance, many potential licensees won't even consider ideas originating from outside their businesses, and return inventors' materials unopened.

In addition, the prosecution of a patent can take several years and cost thousands of dollars, and an issued patent is only the beginning. Enforcing a patent is an ordeal to an individual inventor, as I wrote about in my January, 2001 column, *The Long Walk From the Gobi Desert to the River Styx: How the Poor Inventor Views the System*. I often steer such potential clients to organizations that offer information and support to new inventors seeking to exploit their ideas. The general idea here is to temper their enthusiasm with some reality. This may not get you the potential client's business, but it is the least that any lawyer in our line of work should do for someone thinking about walking barefooted on red-hot coals.

After you have informed your prospective client about how difficult the process is, and assuming there are no conflicts, you can evaluate the idea, or the patent. Remember that you are looking at a patent, and a potential infringement, for the first time. Anyone experienced with reading a patent knows it is like reading one of the tough books you had to read in high school,

say, *East of Eden* or *The Old Man and the Sea*. In other words, reading a patent is hard work, and you rarely have a full understanding after one pass through the patent. Instead, as with Hemingway, your insight is incomplete.

Keep that in mind, particularly if you decide the case is not for you. I try not to write opinion letters in such instances, because I know I am working with a first impression, and I might be wrong. If I am wrong, and I express my views in a letter, I have stuck the patent owner with a written communication, potentially discoverable in a later suit, that says the patent is not infringed, or has a prosecution problem of some kind. Instead of helping the person, you've not only turned him down; you've shot him in the foot, too.

Don't do that. Talk to the person instead, and unless the potential client insists on having something in writing, simply say the case is not for you. If you do get into substance, try to keep it general, and qualify your opinion. I also encourage inventors I have turned down to get a second opinion.

Once a client has retained you, how should you communicate? There is no rule here, and many communications are likely to be oral. There are times, though, when written communications are essential. When that is the case, write the communication with two things in mind. First, write it as though others, including the opposing party and the judge, will see it.

Second, write in such a way that you maximize the application of the attorney-client privilege or work-product immunity to the communication. Hit all the checkboxes for a privileged communication; an individual attorney should sign, so there is an author; address it to a person (your client or your client's representative); and think carefully about sending copies to anyone. Every "cc" is another person to be deposed, and every additional "cc" is a potential basis to argue that a communication was not privileged, or that any privilege was waived.

The substantive content of the letter is obviously significant. Don't just discuss the law. Refer to some facts, too. Then apply the law to those facts. Many persons apply a warning legend to the top of such a letter to alert its readers that it is subject to the attorney-client privilege. It is fine to use one, though I haven't seen a case where the

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existence of the privilege hinged upon the use of a legend.

It may also be useful in some cases to say in writing somewhere in the body of the letter that a letter containing information of a legal nature is not privileged. In one of our cases, the patent prosecutor, who also helped his client negotiate with potential licensees, would write a letter to his client with information meant to be relayed to the potential licensee. In the letter, he negated any expectation of confidentiality (a requirement of the privilege) by telling the client that he understood the information in the letter would be disclosed to the licensee, and that the letter was therefore not protected by the privilege. That made it easy for us as the litigators later on. We produced it at trial, which really helped our case. There's one requirement, however: such letters have to be well written, as they were in our case!

Even a privileged communication should be written as though anyone will see it. That is because, despite your best efforts, and even if your communication is privileged, someone other than the intended recipient may well read it. That could be a jury, a judge or a special master reviewing documents to see if they are privileged. This is a chance, caused by your opposition, to communicate with the court *ex parte!* Use it well.

Conversations between inventor and attorney, face to face or by telephone, are common. As a patent prosecutor becomes more familiar with the technology of a patent application, a quick telephone call

is often enough to answer a question. Or, in a lawsuit, a client and lawyer may have extensive conversations about damages, defenses, infringement, and so forth.

But conversations generate notes. When you have notes, take the time to date them and record the source of the information — that is, your client. There is no obligation to keep such notes, especially once they are incorporated into the application or office action you may be preparing. If you do keep them, insure they fulfill the requirements of the privilege, so they are protected. Date them. Note your client as the source.

That brings us to the most popular form of communication: email. It is a handy tool. I use it. Everybody uses it — well, almost everyone, except for a few old timers I know. But it has its limits. Email is not confidential in the ordinary course of business. That means it is not a suitable means of communicating confidential or privileged information. Nevertheless, convenience seems to override good sense in this respect. There is an ABA opinion that email has a reasonable expectation of privacy, but that is only an opinion of a private body, and I am told one or two states disagree.

Email can be made confidential, at least minimally so. You can encrypt email, which is the best protection. You can at least use a password to protect a document attached to an email. In any case, sending your message "in the clear" is hardly a good idea.

Email proliferates like overheated hamsters. Everybody has group addresses,

automatic addresses, and so forth. You might consider not using auto-completion, a common feature in email programs, which completes an address when you type the first one or two letters. Avoiding this feature will make you very deliberate about who your message is sent to, and negates one of the risks of email — the tendency to dash something off and send it before you think about it. And be sure to minimize cc's on email that is privileged for the same reason you don't put extra cc's on letters.

If you follow these simple guidelines when communicating with clients and prospective clients, your relationship will be off to a better start. Employ your communications wisely. Don't weigh down the clients you reject with inaccurate written communications. For the clients you accept, communicate effectively; speed doesn't justify sloppy techniques that jeopardize the confidentiality of your communications. Write as though others besides your client may some day see your work. **IPT**